



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/725,987	11/29/2000	Tadao Yoshida	450100-02886	1330
20999 7590 10/02/2008 FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151				
EXAMINER				
RAMAN, USHA				
ART UNIT		PAPER NUMBER		
2623				
MAIL DATE		DELIVERY MODE		
10/02/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/725,987

Applicant(s)

YOSHIDA ET AL.

Examiner

USHA RAMAN

Art Unit

2623

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Filing Date: 6-3-06

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 16th 2008 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims 26 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 28 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 28 and 31 recite the limitation "the first listing and the second listing".

There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 26-27, 29-30, 32-36, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Killian (US Pat. 6,163,316) in view of Hassel (US Pat. 2004/0128685).

With regards to claims 26, 29, 32, and 34, Killian discloses a receiver comprising:

A receiving means (10) for receiving digital content and attributive information (see column 3 lines 59-67, column 4 lines 1-7);

Selecting means for comparing a first selective information with the attributive information (see column 2 lines 19-22 and column 17 lines 29-35)

A filtering means for filtering the attributive information on the basis of the first selective information to select the digital content (see column 10 lines 60-67, column 15 lines 5-12); and

Control means for recording on the receiver digital content selected on the basis of the first selective information (column 15 lines 5-12). Killian discloses maintaining plurality of viewer profiles (the first selective based one among the plurality of profiles), comprising individual and/or combined profiles (see column 9 lines 15-19), and wherein programs matching the plurality of profiles are recorded

(see column 15 lines 44-49). Killian additionally discloses that a user can enter a user identity that is used to identify a profile corresponding to the viewer. See column 9 lines 5-9, column 11 lines 50-55. Killian additionally discloses that upon a user entering their identity, the EPG is customized to display "all available" programs matching the profile corresponding to the user identity, however is silent on the step of displaying the recorded programs among the "available programs" in the EPG. In an analogous art, Hassell discloses a system wherein a user may record programs (see [0041]-[0042]), the system comprising an exemplary program guide displaying the recorded content that can be available for immediate reproduction (see [0039]-[0041]) in conjunction with programs current and future broadcast programs (see [0035]). Therefore, it would have been obvious to modify the system of Killian in view of Hassell by identifying recorded programs in conjunction with programs current and future broadcasts, such that all the programs identified in the EPG are customized according to the profile corresponding to the current user identity.

With regards to claims 27, 30, 33 and 35, the system as modified in view of Hassel further comprises removable recordable medium means (see [0008]) configured to store address information (volume names, etc. for identifying location of media, see [0085]-[0086]) of broadcast digital content and client identification (user information stored in user fields, see [0045]).

With regards to claim 36, the system as modified in view of Hassel further discloses the step of a user storing programs to another digital storage device (see Hassell: [0084]). Hassell further discloses that when a user selects a program

currently not loaded in the storage device, the program guide automatically changes the storage medium for playing back the requested program (see [0089]). Hassell therefore teaches without automatically receiving and playing user media (once the storage medium is loaded) based on address information of digital content and client identification stored on the address information of digital content.

Hassell is silent on the step of providing the removable recording medium to a second receiver and automatically playing the content at the second receiver. Examiner takes Official Notice that it is well known to use removable recording medium at a second receiver, so that contents of the recording medium maybe viewed at the second receiver. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Hassell by utilizing the removable recording medium at a jukebox of a second receiver, thereby enabling playback of stored contents at the second receiver.

With regards to claim 38, Killian further discloses wherein the parameter of the first selective information is set to exclude programs from being recorded and reproduced. See column 14 lines 42-55 and column 16 lines 55-57.

7. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Killian (US Pat. 6,163,316) in view of Hassel (US Pat. 2004/0128685) and further in view of Herz (5,758,257)

With regards to claim 37, Killian is silent on the step of analyzing user's tasted based on a reproduced program and changing weighting of a value of a parameter of the first selective information based on the analysis of user's taste thereby

changing the filter configured to filter the attributive information to select the digital content. In a related art of suggesting programs, Herz discloses a method of analyzing suggested programs that a user has watched or not watched in order to adjust weights associated with the customer profile. See column 25 lines 45-48, column 26 lines 63-column 27 line 2. It would have been obvious to one of ordinary skill in the art to further modify the system in view of Herz's teachings by adjusting user profiles based on programs so that suggestion algorithms can be updated by monitoring suggested programs were watched. It is further noted that Killian discloses the plurality of profiles can comprise combined profile.

8. Claims 39 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Killian (US Pat. 6,163,316) in view of Hassel (US Pat. 2004/0128685) and further in view of Zigmond et al. (6,698,020)

With regards to claim 39, while Killian discloses displaying commercials during commercial breaks, Killian is silent on the step of selecting commercial information based on the first selective information and storing the commercial in a dedicated area of the recording medium.

Zigmond discloses the step of storing commercials that match a user profile (see column 19 lines 55-61).

It would have been obvious to one of ordinary skill in the art to further modify the system in view of Zigmond teachings by recording advertisements that match the viewer profile (first selective information) so that the system can display targeted advertisements during commercial breaks.

With regards to claim 40, the stored commercial in the modified system is reproduced within a predetermined time frame (upon detecting triggering event, see Zigmond: column 20 lines 4-7).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Pat. 6,898,762 to Ellis et al.

US Pat. 6,564,005 to Berstis

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to USHA RAMAN whose telephone number is (571)272-7380. The examiner can normally be reached on Mon-Fri: 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Chris Kelley/
Supervisory Patent Examiner, Art
Unit 2623

/Usha Raman/